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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/326,106    06/04/99    GEBEYEHU

G    45-93A

023713    HM12/0718  
GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER CO 80303

EXAMINER
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MARSCHER, A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED:

07/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/326,106

Applicant(s)  
Gebeyehu et al.

Examiner  
Ardin Marschel

Art Unit  
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 16, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-35, and 65-93 is/are pending in the application.
- 4a) Of the above, claim(s) 1-10 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22, 31-35, and 65-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-10, 12-35, and 65-93 are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) ~~PTO-1449~~ 1 sheet 20) ☐ Other:

The letter, filed 5/11/01, requesting the change of serial number on the Petition for a Time Extension, filed 5/11/01, has been received and the serial number corrected as requested.

Applicants traversal arguments regarding the tertiary amine containing claims has been persuasive and therefore claim 81-93 will be examined herein also.

Applicants' arguments, filed 4/16/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 67-93 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 67 and 81 and those claims dependent therefrom via their dependence the A moieties extending to "about 22 carbon atoms" has not been found as filed and therefore is NEW MATTER.

Claims 12-22, 31-35, 65, and 66 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Claim 65, for example, depicts the compounds therein described via a structural formula which contains monomers which are repeated "n" times. The "repeating structure" phrase in line 1 of claim 65 implies that whatever constitutes the  $Z - (R)_m$  structure is repeated identically. This conflicts with the limitations on "m" being 1 at least once and zero at least once when Z is an amino acid. This different value for "m" results in a non-repeating structure due to the monomer subunits with different "m" values being different. An alternative interpretation confusingly would not be actually a repeating structure in the claimed compound but repetition only of the general structure  $Z - (R)_m$ . Is this the intended interpretation of the claims? Clarification of this conflicting wording is requested via clearer claim wording.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 34, 65, and 66 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the Alanine-Glycine containing peptides of the 1990 Sigma Chemical Catalog as listed

below.

In instant claim 65, one option is a compound of  $Z =$  an amino acid, such as glycine, with  $R$  being an alkyl group resulting in Alanine. Thus, a peptide made up of at least Alanine ( $m=1$ ; with  $R =$  methyl) and Glycine ( $m=0$ ) anticipates the above listed claims. Products A 5902 and F 8631 on page 1066 of the 1990 Sigma Catalog contains such a repeating unit. Other peptide options may be also cited, however. It is noted that one possible interpretation of the instant claims is such a compound as noted, albeit with unclarity, in the above rejection under 35 U.S.C. § 112, second paragraph.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.


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Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 29, 2001

  
**ARDIN H. MARSCHEL**  
**PRIMARY EXAMINER**